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Paper No. 31

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte EDWARD W. MOLL

Appeal No. 2002-1635
Application No. 08/835,625

HEARD: March 16, 2004

Before BARRETT, DIXON, and GROSS, **Administrative Patent Judges**.

DIXON, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1, 2, 4, 9, 12, 15, 17, 18, 21, 38, 40, 44, 45, 51, 55, and 67-70.

We REVERSE.

Appellant's invention relates to a system for controlling a computer operation based on stimuli sensed corresponding to a user thought. An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below.

> 1. An apparatus for controlling a computer operation based on one or more stimuli sensed from at least one user thought, said apparatus comprising:
>
> (a) stimuli input means coupled to the user for detecting at least one stimulus being caused by the at least one thought of the user;
>
> (b) a computer having an operating system, coupled to said stimuli input means, for processing said at least one stimulus to produce a function control signal to control the operation of said computer wherein said computer does not require an articulated response from the user, said computer comprising:
>
> (1) function selection means for receiving said at least one stimulus and wherein said function selection means comprises a memory including a correspondence between a plurality of previously-stored user stimuli and a plurality of desired function control signals;
>
> (2) identification means, coupled to said function selection means, for comparing said at least one stimulus to said correspondence to identify a function control signal corresponding to said at least one stimulus, said function control signal being transmitted to the operating system of said computer.

The prior art of record relied upon by the examiner in rejecting the appealed claims is as follows:

Hartzell et al. (Hartzell)	4,949,726	Aug. 21, 1990
Adachi	5,325,133	Jun. 28, 1994
Junker	5,474,082	Dec. 12, 1995
Kuc et al. (Kuc)	5,594,849	Jan. 14, 1997

Claims 1, 55, and 67-70 stand rejected under 35 U.S.C. § 112, first paragraph as failing to provide an enabling disclosure. Claims 1, 4, 9, 12, 15, 17, 21, 38, 40, 51, 55, and 67-70 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Junker. Claim 2 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Junker in view of Kuc. Claim 18 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Junker in view of Hartzell. Claims 44 and 45 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Junker in view of Adachi.

Rather than reiterate the conflicting viewpoints advanced by the examiner and appellant regarding the above-noted rejections, we make reference to the examiner's final rejection (Paper No. 21, mailed Aug. 28, 2000), the examiner's answer (Paper No. 25, mailed Apr. 23, 2001) and the supplemental examiner's answer (Paper No. 27, mailed Oct. 1, 2002) for the examiner's reasoning in support of the rejections, and to appellant's brief (Paper No. 24, filed Feb. 7, 2001) for appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by appellant and the examiner. As a consequence of our review, we make the determinations which follow.

35 U.S.C. § 112, FIRST PARAGRAPH

Appellant argues that the declaration by the inventor Edward Moll, filed Oct. 12, 1999, evidences that detection of a particular stimulus corresponding to a particular thought was known in the art. (See brief at page 13.) In the prosecution history, we find that the examiner has only provided a brief comment at the beginning of the non-final rejection mailed Jan. 6, 2000, which states that the declaration was considered, however it did not obviate the rejection under 35 U.S.C. § 112, first paragraph. Subsequently, in the final rejection, the examiner maintained that essentially, the examiner does not dispute enablement, but that the appellant's use of the claim terminology which the examiner equates to "sensing a user's thoughts" is a "gross misnomer . . . ." (See answer at page 2.) As pointed out by our reviewing court, we must first determine the scope of the claim. "[T]he name of the game is the claim." **In re Hiniker Co.**, 150 F.3d 1362,1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998). Therefore, we look to the language of independent claim 1. The language of

independent claim 1 recites "controlling a computer operation based on one or more stimuli sensed from at least one user thought" and "stimuli input means coupled to the user for detecting at least one stimulus being caused by the at least one thought of the user." While we agree with the examiner that at first blush the claims appear to claim sensing a user's thoughts, it is clear that the system is sensing some stimuli from the thoughts and that the sensed stimuli are used to control the computer based on some stored correspondence. The examiner does not appear to dispute that this was enabled. Here, we do not find that the examiner has established a ***prima facie*** case of a lack of enablement of the invention as claimed, nor do we find that the examiner has adequately addressed the content of the evidence submitted in the form of a declaration by Edward Moll. Therefore, we will not sustain the rejection of claims 1, 55, and 67-70 under 35 U.S.C. § 112, first paragraph.

See pages 4-7 of Ex. Answer

35 U.S.C. § 102

Appellant argues that Junker uses biofeedback and that Junker does not teach the "detecting the [particular] thoughts of the user" as in the present invention. (See brief at page 17.) Here, we find that Junker does use the sensing of brain activity to control a computer, but that it does not sense/detect the stimuli and compare the sensed or detected stimuli to stored stimuli to identify a corresponding control function for a computer. Appellant argues at page 17 et seq. of the brief that the function selection means and the identification means are not taught or suggested by Junker.

We agree with appellant, and do not find that the examiner has shown where or how Junker teaches these claim limitations. Therefore, we do not find that the examiner has established the initial ***prima facie*** case of anticipation, and we will not sustain the rejection of independent claims 1, 55, and 67-70 and dependent claims 4, 9, 12, 15, 17, 21, 38, 40, and 51.

35 U.S.C. § 103

With respect to dependent claims 2 (and 44 and 45)[1], appellant argues that Junker does not teach or suggest the localization of stimuli and that there is no incentive to combine Junker and Kuc (or Adachi). (See brief at pages 24-25.) We agree with appellant that the examiner has not established a convincing line of reasoning why it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the diagnostic imaging of Kuc (or imaging of Adachi) with the biofeedback control system of Junker. Nor has the examiner established how the teachings of Kuc (or Adachi) overcome the deficiencies in Junker. Therefore, we find that the examiner has not established a ***prima facie*** case of obviousness, and we will not sustain the rejection of claims 2, 44 and 45.

[1] While appellant has not specifically argued or combined claims 44 and 45 with claim 2, we will include these claims with claim 2 since appellant argues the lack of a teaching of localization with respect to the input device of Kuc and we imply this to also extend to the teachings of Adachi.

With respect to dependent claim 18, appellant argues that Junker does not teach or suggest the use of the computer for security or identification purposes and that Hartzell does not remedy the deficiency in Junker noted above. (See brief at pages 25-26.) We agree with appellant that the examiner has not established where Hartzell remedies the deficiency in Junker noted above. (See brief at pages 25-26.) We agree with appellant that the examiner has not established where Hartzell teaches or fairly suggests why it would have been obvious to one of ordinary skill in the art at the time of the invention to use the computer for security or identification purposes. Nor has the examiner established how the teachings of Hartzell overcome the deficiencies in Junker. Therefore, we find that the examiner has not established a ***prima facie*** case of obviousness, and we will not sustain the rejection of claim 18.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1, 55, and 67-70 under 35 U.S.C. § 112, first paragraph is reversed; the decision of the examiner to reject claims 1, 4, 9, 12, 15, 17, 21, 38, 40, 51, 55, and 67-70 under 35 U.S.C. § 102 is reversed; and the decision of the examiner to reject claims 2, 18, 44, and 45 under 35 U.S.C. § 103 is reversed.

REVERSED

LEE E. BARRETT
Administrative Patent Judge

JOSEPH L. DIXON
Administrative Patent Judge

ANITA PELLMAN GROSS
Administrative Patent Judge

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